



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,709	05/03/2005	Said Mansouri	MANSOURI, S. - 1 PCT	9628

25889 7590 09/18/2006

WILLIAM COLLARD
COLLARD & ROE, P.C.
1077 NORTHERN BOULEVARD
ROSLYN, NY 11576

EXAMINER

MEHTA, BHISMA

ART UNIT	PAPER NUMBER
----------	--------------

3767

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

88

Office Action Summary	Application No.	Applicant(s)	
	10/533,709	MANSOURI, SAID	
	Examiner	Art Unit	
	Bhisma Mehta	3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/3/2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/20/05, 7/11/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Germany on February 3 2004 and May 7 2004. It is noted, however, that applicant has not filed certified copies of the 10 2004 005 383.9 and 10 2004 023 235.0 application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

2. Parts of the information disclosure statements filed June 20 2005 and July 11 2005 fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Some of the references, which have been crossed out by the examiner, have not been considered because copies of some of the foreign patent documents were not submitted. U.S. Patent No. 5,180,217 was not considered because it appears to be in error as it is not relevant to the invention and it does not agree with the information detailed on lines 11-18 of page 2 of the specification. WO 01/1397 also does not appear to be relevant to the invention. Also, the International Search Report was not considered because it does not include the relevant information on the information disclosure form regarding the title, date, etc.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fitting for connecting a compressed gas supply to a pressurized space, a front element of the slide valve projecting into the first hydraulic chamber, a limit stop for limiting the exit of the indexer piston and a special receiving means for a cannula must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because the figure is not very clear. For example, the exact location of the compression spring (33) and the pressure plate (27) are unclear. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 27a and 37. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each

Art Unit: 3767

drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The abstract of the disclosure is objected to because it contains legal phraseology ("means" in line 8). Correction is required. See MPEP § 608.01(b).
7. The disclosure is objected to because of the following informalities: Reference numeral 15 is used for a pressure plate in line 4 of page 13 and for a piston head in line 9 of page 16. Appropriate correction is required.

Claim Objections

8. Claims 4 and 20 are objected to because of the following informalities: Claim 4 recites the limitation "the pressurization space" in line 3. Claim 20 recites the limitation "the springe" in line 4 of the claim. There is insufficient antecedent basis for these limitations in these claims. Also, the word "springe" appears to be misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 19, it is unclear if applicant is establishing a feed piston, a pressure plate, a first hydraulic chamber, and a second hydraulic chamber in addition to those already established in claim 1 or if applicant is referring to the structures already established in claim 1. Similarly, in claims 20-22, it is unclear if applicant is reciting new structure or referring to structure which has already been recited in claim 1.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-6, 9-12, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Neracher (U.S. Patent Application Publication No. 2002/0055712). In Figure 51, Neracher shows a syringe having a feed piston (113) that is longitudinally slidable in a carpule volume and that has a pressure plate which is connected to a first hydraulic chamber (116) and a second hydraulic chamber (115) which is behind and connected to the first hydraulic chamber. A separator piston (112) is disposed behind the second hydraulic chamber and is slidably mounted such that it is capable of

Art Unit: 3767

reducing the size of the second chamber and of enlarging a pressurization space (i.e. the space within the first hydraulic chamber). The second hydraulic chamber would be caused to become smaller by the same amount as the pressurization space would be enlarged. The end of the syringe would be a fitting for connecting a gas supply or to receive a gas cartridge. The syringe has a slide valve (118) which is capable of closing and opening an opening of a control hole between the first and second hydraulic chambers. As to claims 9 and 10, a touch-sensitive key pad (119) causes the control hole to open at least substantially parallel to the axis of movement of the slide valve when pressed and is disposed at least partially in a front half of the syringe. The axis of movement of the slide valve is disposed perpendicular to a longitudinal axis of the syringe. The spring adjacent to the slide valve as seen in Figure 51 provides a biasing force to close the control hole. The syringe has a special receiving means (120) for a cannula. As to claim 18, the feed piston completely lies within a feed cylinder (9c).

13. Claims 1, 6-19, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Haar et al (U.S. Patent No. 6,440,099). In Figure 2, Haar et al show a syringe having a feed piston (18a) that is longitudinally slidable in a carpule volume and that has a pressure plate (21a) which is connected to a first hydraulic chamber (adjacent to the pressure plate) and a second hydraulic chamber (34a) which is behind and connected to the first hydraulic chamber. A slide valve (33) is capable of closing or opening an opening of a control hole between the first and second chambers. The slide valve has a pressure plate which is connected to the first hydraulic chamber and a front element of the slide valve projects into the first hydraulic chamber. As to claims 9 and

Art Unit: 3767

10, a touch-sensitive key pad (32) causes the control hole to open at least substantially parallel to the axis of movement of the slide valve when pressed and is disposed at least partially in a front half of the syringe. The axis of movement of the slide valve is disposed perpendicular to a longitudinal axis of the syringe. The slide valve is biased with a biasing force closing the control hole where the biasing force is the force that keeps the key pad in the position shown in Figure 2. As to claims 13-16, the valve (33) is considered to be the indexer piston that is connected to the first hydraulic chamber where a foot of the indexer piston projects into the first chamber. The indexer piston is slidably mounted and has a limit stop (the portion of the syringe where the key pad abuts the syringe in Figure 2). The indexer piston is considered to be mounted such that it is biased against an exit direction. The syringe has a special receiving means (20) for a cannula. As to claim 18, the feed piston completely lies within a feed cylinder (23). As to claim 22, the position of the indexer piston within the syringe (i.e. as positioned in Figure 2 and as positioned in Figure 3) would make the pressure in the hydraulic chamber optically recognizable.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Castellano et al (U.S. Patent No. 5,730,723) and Neracher (U.S. Patent Application Publication No. 2004/0055662) disclose injection syringes having hydraulic chambers.

Art Unit: 3767

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bhisma Mehta whose telephone number is 571-272-3383. The examiner can normally be reached on Monday through Friday, 7:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BM

BM

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

Kevin C. Sirmons